

comparative example 3 in Yamanaka et al. '225 to support this contention.

Applicants' Response

Applicants submit that claims 1-16 are enabled by the specification and are thus patentable. First, the Examiner has inappropriately shifted the burden to the Applicants to show why a particular phenomena occurs, which is not a hurdle to overcome for patentability. "[I]t is not a requirement of patentability that an inventor correctly set forth, or even know, how or why the invention works." Newman v. Quigg, 877 F.2d 1575, 1581, 11 USPQ2d 1340, 1345 (Fed. Cir. 1989); see also Fromson v. Advance Offset Plate, Inc., 720 F.2d 1565, 1570, 219 USPQ 1137, 1140 (Fed. Cir. 1983) (" [I]t is axiomatic that an inventor need not comprehend the scientific principles on which the practical effectiveness of his invention rests.").

Second, Applicants submit that they have not yet discovered a rationale for a multilayer film, which has tear strength in the machine direction that is much higher than the tear strength in the transverse direction. Applicants suppose that the phenomena is achieved by the multilayer film having at least two layers composed of different kinds of resin. An example is a

multilayer film having two layers composed of polypropylene as outer layers and one inner layer composed of polyethylene. An oriented multilayer film has layers of oriented resin, such as polypropylene, and a layer of non-oriented resin such as polyethylene. The oriented multilayer film as described has resistance to tearing in the machine direction due to the non-oriented polyethylene. Also, in the case where the outer layers are composed of polyethylene and the inner layer is composed of polypropylene, the same results are obtained. However, Applicants have not yet understood clearly the reason why the tear strength in a transverse direction is also decreased.

Third, Applicants submit that the specification adequately teaches one of ordinary skill in the art how to make and use the instant invention. As described at page 6, lines 3-9 of the specification, where the inner layer and at least one of the outer layers are laminated directly with each other, the raw materials forming the inner layer are preferably not the same as those forming at least one outer layer that is adjacent thereto. Thus, the multilayer film of the instant invention has at least two layers composed of two different kinds of resin.

Furthermore, all examples disclosed in the specification also show the oriented multilayer films as claimed. For example, in Example 3, ethylene-hexane-1 copolymer having a melting temperature of 111°C was used as an inner layer, and propylene-ethylene copolymer having a melting temperature of 158°C was used as an outer layer. The resulting multilayer film was drawn at 120°C. Thus, the claimed multilayer film was obtained. See also Example 1, where a propylene based block copolymer which has a melting point of 136°C, was used as the outer layer (see page 20, line 2) and ethylene-vinyl acetate copolymer which has a melting point of from about 80°C to about 90°C, was used as the inner layer. In both Examples, the non-oriented multilayer films were drawn at a temperature between lower than the higher melting temperature of the outer layer resin and higher than the lower melting temperature of the inner layer resin.

As Applicants have demonstrated that the rejection is improper and, in the alternative, established that the instant invention is adequately described in the specification, Applicants submit that claims 1-16 should be allowed.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully

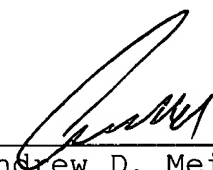
requested to contact Kecia J. Reynolds (Reg. No. 47,021) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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By



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